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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/411,863	10/04/99	IZHAR	S 1620/3

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EXAMINER

FOX, D

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

12/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary**Application No.**

09/411,863

Applicant(s)

IZHAR, SHAMAY

Examiner

David Fox

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/04/99.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2, 6, 8-9, 19-23, 26, 31, 34, 36-39, 43, 46 and 48, drawn to an animal transformed with two exogenes comprising at least one cytotoxic-encoding gene, classified in class 800, subclass 22, for example.
- II. Claims 3-5, 24-25, 28-30, 33, 35, 40-42 and 45, drawn to an animal transformed with an exogene encoding a transactivating factor including RNA polymerase, classified in class 435, subclass 193, for example.
- III. Claims 7, 27, 32 and 44, drawn to an animal transformed with an exogene encoding antisense RNA or ribozymes, classified in class 536, subclass 24.5, for example.
- IV. Claims 10, 47 and 49-55, drawn to a plant transformed with two exogenes which result in male sterility, and a method for making the plant, classified in class 800, subclass 303, for example.
- V. Claims 11-13 and 16-18, drawn to a plant transformed with a gene encoding an RNA polymerase, classified in class 800, subclass 278, for example.
- VI. Claims 14-15, drawn to a plant transformed with a gene encoding a cytotoxic molecule and with a gene encoding an RNA polymerase, classified in class 800, subclass 279, for example.

The inventions are distinct, each from the other because:

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Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different effects.

The inventions of Groups I-III require transformed animals and methods for animal transformation and culture, not required by the inventions of Groups IV-VI. The inventions of Groups IV-VI require transformed plants and methods for their transformation and culture, not required by the inventions of Groups I-III.

The inventions of Groups II and V-VI require genes encoding transactivating factors such as RNA polymerase and a second promoter with a transactivating-responsive element, each not required by any other group.

The invention of Group III requires genes encoding non-proteinaceous materials such as antisense RNA or ribozymes, and methods for evaluating gene inhibition and phenotypic effects thereof, each not required by any other group.

The invention of Group IV requires genes encoding products resulting in male sterility in plants, not required by any other group.

The invention of Group VI requires the combination of plant transformation techniques, genes encoding a multitude of cytotoxic polypeptides such as the insecticidal *Bacillus thuringiensis* toxin, and genes encoding a bacterial RNA polymerase, each not required by any other group.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37

CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November 30, 2000

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180-1638

A handwritten signature in black ink, appearing to read "David T. Fox", written over the printed name and group number.